

REMARKS

Claim 11 is canceled without prejudice, and therefore claims 9, 10 and 12 to 16 are now pending and being considered.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

It is again respectfully requested that the Office acknowledge whether the drawings are accepted.

With respect to paragraph three (3) of the Office Action, Applicants thank the Examiner for indicating that claim 13 includes allowable subject matter. Since it is believed that the base claim, as presented, is allowable, as explained below, the objection is respectfully traversed for the reasons explained below. It is therefore respectfully requested that the objection be withdrawn.

With respect to paragraph two (2) of the Office Action, claims 9 to 12 and 14 16 were rejected under 35 U.S.C. § 102(b) as anticipated by Kadowaki et al., U.S. Patent No. 6,047,674.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the anticipation rejections may not be agreed with, to facilitate matters, claim 9 has been rewritten to better clarify the subject matter of the claim, so that it now provides that the “if there is a system deviation between the actual setting and the setpoint setting, *forming a multi-stage fault signal as a function of the system deviation*” -- as opposed to forming a fault signal in multiple stages (which is wholly different), and so that it now includes the claim 11 feature in which *a stage of greater weighting is reached with increasing system deviation*.

In particular, claim 9 has been rewritten to provide that the fault signal is a multi-stage fault signal that is formed as a function of the system deviation -- and not a fault signal that is formed in multiple stages, which is entirely different.

In contrast, the “Kadowaki” reference does not identically describe (or even suggest) the claim 9 feature of *forming a multi-stage fault signal as a function of the system deviation*”, and the claim 11 feature which provides that *a stage of greater weighting is reached with increasing system deviation*, as provided for in the context of claim 9 as presented. Claim 11 has been canceled without prejudice, since its feature has been included in claim 9 as presented.

In particular, in step S107 of the Kadowaki reference, it indicates that an actual deviation is compared with a single limit value, and in step S109 it is determined whether this fault has occurred more often than a stipulated number of faults. If this fault has occurred more often, there is a fault.

With the presently claimed subject matter, multi-stage fault signals are triggered as a function of the system deviation. This has the advantage, for example, that for large system deviations, a fault reaction is immediately initiatable (so that, for example, the driver may be informed immediately), whereas, for example, for slight system deviations, the fault event may be stored for later informing the driver. Thus, the “Kadowaki” reference does not identically describe (or even suggest) the claim 9 feature of *forming a multi-stage fault signal as a function of the system deviation*”, and the feature which provides that *a stage of greater weighting is reached with increasing system deviation*.

In particular, the "Kadowaki" reference does not in any way identically describe (or even suggest) forming "multi-stage fault signals" as a function of the system deviation (that is, the deviation of the actual crankshaft angle from the setpoint crankshaft angle), increasing the weighting of the multi-stage fault signal as the setpoint/actual deviation increases.

Claim 9 is therefore allowable, as are its dependent claims 10, 12 and 13.

Claims 15 and 16, as presented, include features like those of claim 9 as presented, and are therefore allowable for essentially the same reasons as claim 9 as presented.

It is therefore respectfully submitted that claims 9, 10 and 12 to 16, as presented, are allowable.

Conclusion

It is therefore respectfully submitted that all of pending and considered claims 9, 10 and 12 to 16, as presented, are allowable. It is therefore respectfully requested that the objection and rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

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Respectfully submitted,

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